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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,954	03/30/2001	David W. Cannell	05725.0637-00	7371

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EXAMINER

SHARAREH, SHAHNAM J

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 04/18/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/820,954

Applicant(s)

CANNELL ET AL.

Examiner

Shahnam Sharareh

Art Unit

1617

-The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.
- NOTE: _____
3. ☐ Applicant's reply has overcome the following rejection(s): _____
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 37,39,41,43,47-49,58,60-63 and 66-77.

Claim(s) withdrawn from consideration: 1-36,40,42,44-46,50-57,59,64 and 65.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____


RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200

Continuation of 5. does NOT place the application in condition for allowance because: of the following reasons: (a) With respect to Williams US Patent 5,679,344 and Noel US patent 5,141,964, Applicants argue that the functional limitation of "wherein said composition is heat-activated" is not taught in Williams nor Noel, therefore, said references can not anticipate the instant product claims. In response Examiner states that during patent prosecution claims are interpreted given their broadest interpretation consistent with the specification (see MPEP2111). The instant compositions comprise two elemental components: (i) at least one compound comprise at least one C5 to C7 saccharide unit substituted with at least one amino group such as glucosamine (as the elected species, Paper No 7), and (ii) effective amounts thereof to protect keatin fibers from extrinsic damage. Accordingly, absent of showing credible evidence, any prior art composition that comprise these two components anticipates the composition as a whole, because all functional limitations associated with such composition is inherent to the composition as a whole. Since the instantly claimed compositions contains two essential components within the generic claims, namely glucosamine in effective amounts, the prior art of record properly anticipates them. Williams and Noel teach compositions comprising glucosamine in amounts that overlap with the instantly disclosed effective amounts of 0.1% to 10% (set forth in claims 58, 60). Therefore, Williams and Noel are anticipatory references. With respect to Heisey reference WO 01/93831, Applicant argues that Heisey is not a prior art because it did not designate the United States. In response, Examiner states that such arguments raise new issues requiring further consideration, because applicants were in proper notice prior to the filing of the last response, yet did not raise this issue until claims were finally rejected. The Heisey publication is a direct continuation of a US filing Application SN 09/759,965, Pub. No. US 2002/0132780 which effectively put applicant in proper notice of an equivalent US application published in Sep 19, 2002. The content of said US filing is essentially identical to the WO publication. Accordingly, Applicant was in proper notice prior to the filing of the last response. Furthermore, the merits of the rejection after final is not addressed. Thus, the argument is not found persuasive as they are found non-responsive to the merits of the rejection. Moreover, the prosecution on the merits is effectively closed; and the arguments presented raise new issues on availability of a prior art. Therefore, they are not persuasive because the claims are still obvious in view of Heisey's earlier teachings.

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